

## **REMARKS**

This responds to the Office Action dated May 2, 2007. Claims 10-32 remain pending and were subject to examination in the first Office Action. Claim 23 has been amended.

Initially, Applicants' counsel notes that the Office Action summary page indicates that claims 10-32 stand rejected, however, the body of the Office Action fails to address claims 15, 20 and 26. Therefore, in the next communication from the Examiner, Applicants respectfully request clarification concerning the status of claims 15, 20 and 26.

### **The Rejection of Claims 10-14, 16-17, 23, 25 and 27 Under 35 U.S.C. § 102(b) as Being Anticipated by Bright**

The Bright publication (Publication No. WO 01/79111) relates to a method and apparatus for continuous application of hot melt adhesive and includes a feedback control system having various sensors that output signals to a controller for purposes of controlling various aspects of the apparatus. The Examiner alleges that Bright discloses "a controller (60) operating a melting unit (30) which comprises wirelessly receiving information on at least one system condition (height in tank, color of adhesive, temperature or viscosity) into the controller from a machine readable element (sensor)."

Claims 10 and 23 are the independent claims of this rejected group. Claim 10 recites a method including "wirelessly receiving information on at least one system condition into the controller from a machine readable element." Claim 23 recites "wirelessly receiving information from a machine readable element regarding a hot melt adhesive to be dispensed." Contrary to the Examiner's interpretation of the Bright

publication, one of ordinary skill in the art reviewing the present claims in light of Applicants' specification would not consider the sensors disclosed in the Bright publication to be "machine readable elements." The term "machine readable elements" as used in the present specification, and in accordance with its ordinary and customary meaning, refers to an element that has stored information which is read or received by an appropriate reading unit such as, for example, an optical, magnetic or electronic reading unit. The information is wirelessly received as set forth in Applicants' claims 10 and 23. Contrary to this, the Bright publication discloses a conventional type of sensor feedback system that involves a sensor detecting a system condition and providing an output signal to a controller. This is clear from a review of page 8, lines 19-22; page 8, lines 31-32; and page 9, lines 6-8 in the Bright publication. Furthermore, there is no indication that the signals provided by the sensors in the Bright system are wirelessly transmitted. Instead, Fig. 4 of the Bright publication illustrates conventional wire connections between sensors 58, 62, 66 and controller or PC 60. For at least these reasons, the rejection of claims 10-14, 16-17, 23, 25 and 27 should be withdrawn.

**The Rejection of Claims 10, 16, 18, 21-23 and 25 Under 35 U.S.C. § 103(a) as Being Unpatentable over Jackson, Jr. and Strickland**

The Examiner cites the Jackson, Jr. patent (U.S. Patent No. 5,719,378) as disclosing a process for operating a hot melt adhesive system using a controller and a melting unit. The Examiner admits that the Jackson, Jr. patent fails to teach the steps recited in the bodies of claims 10 and 23. The Examiner appears to have paraphrased the body of claim 10 on page 4 of the Office Action, lines 3-5. For the record, the method of claim 23 is differentiated from the method of claim 10 and recites:

wirelessly receiving information from a machine readable element regarding a hot melt adhesive to be dispensed,

utilizing the received information in the controller to set a system condition of the hot melt adhesive dispensing system, and

operating the hot melt adhesive dispensing system according to the system condition to dispense the hot melt adhesive.

The Examiner has essentially admitted that the primary reference, which is the only reference used in the rejection that concerns the operation of a hot melt adhesive system, fails to disclose any of the steps recited in independent claims 10 and 23. These steps are therefore not found in the Jackson Jr. patent, as admitted by the Examiner, and must instead be found in some other prior art reference or teaching to establish a *prima facie* case of obviousness. For this purpose, the Examiner has turned to the Strickland publication. Applicants' counsel has reviewed the earlier provisional application associated with the Strickland publication since the utility application of Strickland does not have a filing date prior to the filing date of the present application and, therefore, does not qualify as prior art.

Strickland's provisional application relates to a method for automatic setup configuration of computer numerical controls using a database. Specifically, such "CNC" machines are used in the machine tool industry to machine component parts as discussed in the Strickland provisional application. Relative to the Examiner's proposed combination, there is no reason to believe that one of ordinary skill in the art of hot melt adhesive dispensing systems would turn to the machine tool industry and, specifically, the CNC industry to make improvements involving the operation of hot melt adhesive

dispensing systems. The fact that both industries happen to involve the use of manually input data, alone, is insufficient evidence to establish that one of ordinary skill in the art of hot melt adhesive dispensing would turn to the art of machine tools and, in particular, CNC machine controls. Moreover, the background of Strickland's provisional application speaks of problems very specific to the computer numerical control industry, or machine tool industry. This involves coordination between component vendor and machine manufacture and associated problems that would not exist in the hot melt adhesive dispensing industry.

Regarding the interrelation of obviousness and nonanalogous art, the Federal Circuit and its predecessor court, the Court of Customs and Patent Appeals, have stated:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", . . . --in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

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In revolving the question of obviousness under 35 U.S.C. § 103, we presume full knowledge by the inventor of all the prior art in the field of the endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. . . . The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. In re Wood, 202 USPQ2d 171, 174 (C.C.P.A. 1979).

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The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of

varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories.

Wang's SIMMs were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. . . . In contrast, the Allen-Bradley patent relates to a memory circuit for a larger, more costly industrial controller. . . . Thus, there is substantial evidence in the record to support a finding that the Allen-Bradley prior art is not reasonably pertinent and is not analogous. Wang Laboratories, Inc. v. Toshiba Corp., 36 USPQ2d 1767, 1773 (Fed. Cir. 1993).

In the present case, there is no reason to believe that one of ordinary skill in the hot melt adhesive dispensing art would turn to the machine tool or CNC field to address problems related to establishing system heating and dispensing conditions or other fluid handling or dispensing conditions. Art involving machine tool set up, such as spindle speed and positioning, for purposes of machining component parts, simply would not commend itself to one of ordinary skill in the art of hot melt adhesive dispensing, absent improper hindsight analysis. One of ordinary skill in the art of hot melt adhesive dispensing would not reasonably be expected to look for a solution to such adhesive dispensing issues in the machine tool or CNC field. The hot melt adhesive dispensing field involves equipment and processes for delivering adhesive during manufacturing processes, such as adhesively securing product components together or adhering parts of packaging together. The Strickland publication concerns the use of machine tools and, particularly, CNC machine tools to form final products or component parts. These fields are disparate from one another to the point that it would not be reasonable to expect one of ordinary skill in the art to look to the machine tool industry for solutions to problems faced in the adhesive dispensing industry.

For at least these reasons, the combination of Jackson, Jr. and Strickland fails to present a *prima facie* case of obviousness and Applicants respectfully request that the rejection of claims 10, 16, 18, 21-23 and 25 be withdrawn.

#### **The Rejection of Claims 19 and 24**

Claims 19 and 24, which respectively depend from independent claim 10 and 23, were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Jackson, Jr. and Strickland combination as applied to claim 10, and further in view of the Hoffer et al. reference. These dependent claims are respectfully submitted to be allowable for at least the same reasons as their respective independent claims as the Hoffer reference fails to cure the deficiencies of the combination involving Jackson, Jr. and Strickland as discussed above.

#### **The Rejection of Claims 28-32**

Claims 28-32 depend directly or indirectly from independent claim 23. The Examiner rejected claims 28-32 as being unpatentable over the Jackson, Jr./Strickland/Hoffer et al. combination further in view of the Droz reference. While the Examiner referred to claim 23 in the first sentence of this rejection, it appears that the Examiner meant to refer to claim 24 since the Hoffer et al. reference was not applied to claim 23. In any event, the Droz reference fails to cure the basic deficiencies of the Jackson, Jr. and Strickland combination for the reasons discussed above in connection with independent claims 10 and 23. Therefore, dependent claims 28-32 are respectfully submitted to be in allowable condition for at least the same reasons as their respective independent claims.

If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicants do not believe that any fees are due in connection with this response. However, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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